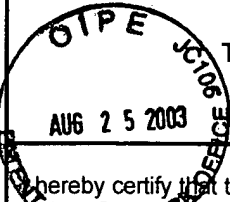
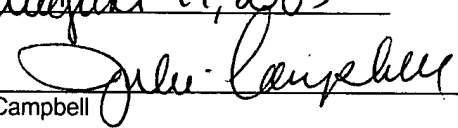


<div style="display: flex; justify-content: space-between; align-items: center;"> <div style="text-align: center;">  <p>TRANSMITTAL OF APPEAL BRIEF (IN TRIPLICATE)</p> </div> <div style="border: 1px solid black; padding: 5px;"> Docket No. (Optional): 050119-1060 </div> </div>											
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Mail Stop Appeal Brief; Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on</p> <p style="text-align: center; font-size: 1.2em;">August 19, 2003</p> <p style="text-align: center;">  Signature – Julie Campbell </p>	<table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td colspan="2">In re Application of Jones</td> </tr> <tr> <td style="width: 60%;">Application Number 09/516,288</td> <td style="width: 40%;">Filed 03/01/00</td> </tr> <tr> <td colspan="2">For Package Delivery Notification System and Method</td> </tr> <tr> <td>Group Art Unit 3621</td> <td>Examiner James a. Reagan</td> </tr> <tr> <td colspan="2">Confirmation No.: 3471</td> </tr> </table>	In re Application of Jones		Application Number 09/516,288	Filed 03/01/00	For Package Delivery Notification System and Method		Group Art Unit 3621	Examiner James a. Reagan	Confirmation No.: 3471	
In re Application of Jones											
Application Number 09/516,288	Filed 03/01/00										
For Package Delivery Notification System and Method											
Group Art Unit 3621	Examiner James a. Reagan										
Confirmation No.: 3471											

Transmitted herewith in **triplicate** is the Appeal Brief in this application with respect to the Notice of Appeal filed on August 18, 2003

The fee for this Appeal Brief is (37 CFR 1.17(c)) \$ 160.00

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.17(a)-(d) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

<input type="checkbox"/> One month (37 CFR 1.17(a)(1))	\$ 55.00
<input type="checkbox"/> Two months (37 CFR 1.17(a)(2))	\$ 205.00
<input type="checkbox"/> Three months (37 CFR 1.17(a)(3))	\$ 465.00
<input type="checkbox"/> Four months (37 CFR 1.17(a)(4))	\$ 725.00

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that the applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Method of Payment:

☐ Payment is enclosed as follows:

☐ A check in the amount of _____ enclosed.

☒ Payment by credit card. Form PTO-2038 is attached in the amount of 320.00

☐ The Commissioner is authorized to charge _____ to a Deposit Account

☒ The Commissioner is hereby authorized to charge any deficiencies in fees, or credit any overpayment to Deposit Account No. 20-0778, a duplicate copy is enclosed.

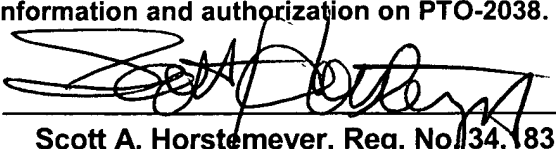
RECEIVED

SEP 03 2003

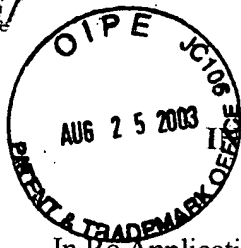
GROUP 3600

08/18/03

_____ Date


 Scott A. Horstemeyer, Reg. No. 34,183

Warning: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.



PATENT

#19
9-9-03
mel

THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:

Martin Kelly Jones

Serial No.: 09/516,288

Filed: March 1, 2000

For: **Package Delivery Notification System
and Method**

)
)
) Group Art Unit: 3621


)
) Examiner: Reagan, James A.

)
) Confirmation No. 3471

)
) Attorney Docket: 50119-1060
)

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450 Alexandria, Virginia 22313-1450, on August 19, 2003.


Signature - Julie Campbell

APPEAL BRIEF UNDER 37 C.F.R. §1.192

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This is an appeal from the decision of Examiner James A. Reagan, Group Art Unit 3621, of June 27, 2003, rejecting claims 1-37 in the present application. Three copies have been provided, in accordance with 37 C.F.R. § 1.192(a).

RECEIVED

SEP 03 2003

GROUP 3600

I. REAL PARTY IN INTEREST

The real party in interest is the assignee, ArrivalStar, Inc., a corporation, having its principal place of business at 219 NE 1st Avenue, Delray Beach, Florida 33444. The assignment was recorded on September 30, 2002, on reel 013333, at frame 0107.

II. RELATED APPEALS AND INTERFERENCES

There are no known related appeals or interferences that will affect or be affected by a decision in this appeal.

III. STATUS OF THE CLAIMS

All pending claims 1-37 stand rejected. Although the rejections are non-final, claims 1-23 have been rejected 3 times, enabling this appeal under 35 U.S.C. 134(a). The latest Office Action (Paper No. 16, mailed Jun. 27, 2003, hereafter The Action) specifically rejected claims 1-4, 24-27, and 36 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,006,159 to *Schmier et al.* (hereafter *Schmier*) in view of U.S. Patent 5,153,842 to *Dlugos Sr. et al.* (hereafter *Dlugos*) and further in view of Applicant's own alleged admission. Claims 5-7, 9, 10, 12-19, 21, 28, 29, 31, and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Schmier*, *Dlugos*, and Applicant's disclosure in view of Hitchcock, Nancy, *The Big Hiccup*, APPAREL INDUSTRY MAG., Apr. 1996, at 16-28. (hereafter Hitchcock). Claims 8 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Schmier*, *Dlugos*, Applicant's disclosure, and Hitchcock in view of *Bar Code*, AUTOMATIC ID NEWS, Jun. 1999 (hereafter *Bar Code*). Claims 11, 20, 32, and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Schmier*, *Dlugos*, Applicant's disclosure, and Hitchcock in further view of U.S. Patent 4,297,672

to *Fruchey et al.* (hereafter *Fruchey*). Claims 22, 23, 34, and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Schmier, Dlugos*, Applicant's disclosure, and Hitchcock in further view of U.S. Patent 5,122,959 to *Nathanson et al.* (hereafter *Nathanson*). For the reasons set forth herein, Applicant appeals the rejection of claims 1 – 37 and respectfully requests that these rejections be overturned, and further requests allowance of all claims 1 – 37.

IV. STATUS OF AMENDMENTS

No claim amendments have been submitted since the latest Office Action, and all claim amendments submitted prior to that have been entered.

V. SUMMARY OF THE INVENTION

The invention disclosed can be viewed, in one embodiment, as a package delivery notification system incorporating a system manager, which upon assigning a package to a delivering vehicle, sends a notification message to a recipient of the package, possibly in the form of an email, informing the recipient of the impending delivery, preferably indicating the approximate time that the package is expected to arrive. p. 3, lines 18-22.

Looking at another embodiment of the invention in detail, disclosed is a system for reporting impending vehicle deliveries comprising memory 32, a first communications device 61 and a system manager 30. Fig. 2. The memory 32 stores a vehicle schedule 37 which identifies packages that are to be respectively delivered to a plurality of recipients by a vehicle during a first time period and indicates an order that the vehicle is expected to deliver the packages. Specification, p. 8, lines 15-19. The first communications device 61 is configured to establish communication with remote communications devices. p. 7, lines 12-23. The system manager 30

is configured to analyze the vehicle schedule and to determine, based on the order, a second time period that the vehicle is expected to deliver one of the packages. p. 9, lines 6-11. The system manager 30 is further configured to transmit a notification message for a respective one of the recipients via the communications device, where the notification message identifies the second time period. p. 11, lines 15-18. A second embodiment of the invention comprises configuring the system manager to detect when one of the packages has been assigned to a vehicle for delivery to one of the recipients, and thereafter transmitting a notification message for a respective one of the recipients. p. 11, lines 8-14.

The present invention can also be viewed as providing a method for reporting impending vehicle deliveries. The method can be broadly conceptualized by the following steps: receiving a plurality of packages; assigning each of the packages to a vehicle; determining an order that the vehicle is to deliver the packages; determining, based on the order, a time period during which the vehicle is expected to deliver one of the packages to a recipient; causing a notification message to be transmitted to the recipient based on the determining a time period step; indicating the time period via the notification message; simultaneously transporting each of the packages via the vehicle; and transporting the package to a premises of the recipient via the vehicle. Specification, p. 11, lines 15-24. Yet another embodiment of the invention involves a method comprising the steps of detecting when the package is assigned to the vehicle and thereafter transmitting the notification message to a recipient communications device. p. 11, lines 8-14.

The invention can also be viewed as a system for reporting impending vehicle deliveries, comprising means for receiving a plurality of packages; means for assigning each of the packages to a vehicle; means for determining an order that the vehicle is to deliver the packages; means for determining, based on the order, a first time period that the vehicle is expected to deliver one of

the packages to a recipient; means for causing a notification message to be transmitted to the recipient indicating the first time period; means for simultaneously transporting each of the packages via the vehicle; and means for transporting the package to a premises of the recipient via the vehicle. Specification, p. 11, lines 15-24. Another embodiment of the invention involves a method comprising means for detecting when the package is assigned to the vehicle and means for thereafter transmitting the notification message to a recipient communications device. p. 11, lines 8-14.

VI. ISSUES

The following issues need to be decided as part of this appeal:

Issue One: Are rejected claims 1-4, 24-27, and 36 patentable under 35 U.S.C. §103(a) over *Schmier* in view of *Dlugos* and Applicant's own disclosure?

Issue Two: Are rejected claims 5-7, 9, 10, 12-19, 21, 28, 29, 31, and 33 patentable under 35 U.S.C. §103(a) over *Schmier* in view of *Dlugos*, Applicant's own disclosure, and Hitchcock?

Issue Three: Are rejected claims 8 and 30 patentable under 35 U.S.C. §103(a) over *Schmier* in view of *Dlugos*, Applicant's own disclosure, Hitchcock, and Bar Code?

Issue Four: Are rejected claims 11, 20, 32, and 37 patentable under 35 U.S.C. §103(a) over *Schmier* in view of *Dlugos*, Applicant's own disclosure, Hitchcock, and *Fruchey*?

Issue Five: Are rejected claims 22, 23, 34, and 35 patentable under 35 U.S.C. §103(a) over *Schmier* in view of *Dlugos*, Applicant's own disclosure, Hitchcock, and *Nathanson*?

VII. GROUPING OF THE CLAIMS

The claims are divided into nine (9) claim groupings, as set out below. For purposes of the argument set forth in this appeal brief, one claim from each group will be evaluated and discussed in connection with the prior art. The claim groups include:

- (1) Group A, which comprises claims 1-4, 36;
- (2) Group B, which comprises claims 24-27;
- (3) Group C, which comprises claims 5-7, 9, 10;
- (4) Group D, which comprises claims 12-15;
- (5) Group E, which comprises claims 16-19, 21;
- (6) Group F, which comprises claims 28, 29, 31, 33;
- (7) Group G, which comprises claims 8, 30;
- (8) Group H, which comprises claims 11, 20, 32, 37; and
- (9) Group I, which comprises claims 22, 23, 34, 35.

A. Reasons that claim groups do not stand or fall together

Although, in reality, all claims of an application are distinct and should be separately construed, Applicant has grouped the claims of the present application into nine (9) distinct claim groups for purposes of simplicity in this Appeal. One claim for each group has been chosen as an exemplary claim. The reason that the claims for any given group do not stand or fall with any claims of another group is, ultimately, because they are of patentably distinct scope. This differing scope is more specifically set out below.

Issue One

In regard to claim group A, claim 1 (the exemplary claim) is broadly directed to a system for reporting impending vehicle deliveries which comprises a memory storing a vehicle schedule identifying packages that are to be delivered to a plurality of recipients, a communications device, and a system manager configured to analyze the vehicle schedule and transmit a notification message for one of the recipients. Claims 2-4 and 36 stand or fall together with claim 1 as a group because they each depend from the system of independent claim 1.

In regard to claim group B, claim 24 (the exemplary claim) is broadly directed to a system for reporting impending vehicle deliveries comprising means for receiving a plurality of packages, means for assigning each of the packages to a vehicle, means for determining an order of delivery, means for causing a notification message to be transmitted to a recipient, and means for transporting a package to a premises of the recipient. Claims 25-27 stand or fall together with claim 24 as a group because they each depend from the system of independent claim 24. The claims of group B differ from group A in that the exemplary claims are of differing scope.

Issue Two

In regard to claim group C, claim 5 (the exemplary claim) is broadly directed to a system for reporting impending vehicle deliveries comprising a memory storing package data for packages that are to be delivered to a plurality of recipients, a communications device, and a system manager configured to detect when a package is assigned to a vehicle and to transmit a notification message for a recipient thereafter. Claims 6, 7, 9, and 10 stand or fall together with claim 5 as a group because they each depend from the system of independent claim 5.

In regard to claim group D, claim 12 (the exemplary claim) is broadly directed to a method for reporting impending vehicle deliveries comprising the steps of receiving a plurality of

packages which are assigned to a vehicle, determining an order of delivery for the vehicle, causing a notification message to be transmitted to a recipient, and transporting a package to a premises of the recipient. Claims 13-15 stand or fall together with claim 12 as a group because they each depend from the method of independent claim 12.

In regard to claim group E, claim 16 (the exemplary claim) is broadly directed to a method for reporting impending vehicle deliveries comprising the steps of receiving a package for delivery to a premises of a recipient, assigning the package to a vehicle, detecting the assignment, thereafter transmitting a notification message to a recipient communication device, and transporting said package to said premises via the vehicle. Claims 17-19 and 21 stand or fall together with claim 16 as a group because they each depend from the method of independent claim 16.

In regard to claim group F, claim 28 (the exemplary claim) is broadly directed to a system for reporting impending vehicle deliveries comprising means for receiving a package for delivery to a premises of a recipient, means for assigning each of the packages to a vehicle, means for detecting the assignment, and means for producing and transmitting a notification message to a recipient communications device. Claims 29, 31, and 33 stand or fall together with claim 28 as a group because they each depend from the system of independent claim 28. Ultimately, the claims of groups C, D, E, and F differ in that the exemplary claims are of differing scope.

Issue Three

In regard to claim group G, claim 8 (the exemplary claim) depends from the system of claim 5, adding the elements that the package data indicates whether the package has been assigned to the vehicle, and that the system detects when the package has been assigned to the vehicle by analyzing the package data. Claim 30 stands or falls together with claim 8 as a group

because it contains similar additional limitations, although it depends from a separate independent claim of differing scope.

Issue Four

In regard to claim group H, claim 11 (the exemplary claim) depends from the system of claim 5, adding the element that the system manager is further configured to determine when the vehicle is within a predefined proximity of a premises of a recipient based on signals transmitted from the vehicle, the system manager further configured to thereafter transmit a second notification message. Claim 37 stands or falls together with claim 11 as a group because claim 37 depends from claim 11. Claims 20 and 32, although of differing scope, stand or fall together with claim 11 because they add similar limitations to their respective independent claims.

Issue Five

In regard to claim group I, claim 23 (the exemplary claim) depends from the method of claim 16, adding the steps of maintaining a web page, receiving contact information via the web page, and utilizing the contact information to perform the transmitting step. Claim 22 stands or falls together with claim 23 as a group because both claims depend ultimately from independent claim 16. Claims 34 and 35, although of differing scope, stand or fall together with claims 22 and 23 because they add similar limitations to their respective independent claim.

VIII. ARGUMENT

Applicant respectfully requests that the Board overturn the rejection of claims 1-37 for at least the reasons discussed below.

A. Issue One

1. Discussion of Group A: Claims 1 – 4 and 36 are patentable over *Schmier*, *Dlugos*, and Applicant's own disclosure

The Office Action rejected claim 1 (the exemplary claim) under 35 U.S.C. § 103(a) as being unpatentable over *Schmier* in view of *Dlugos* and Applicant's own disclosure. Applicant requests that the rejection of claim 1 be overturned and submits that the rejection was improper for at least the reasons that (a) the combination of references fails to teach each and every element of claim 1, (b) the *Schmier* reference is not analogous art for purposes of 35 U.S.C. § 103, and (c) the references cited offer no suggestion or motivation for their combination. Each of these reasons are distinct and will serve as an independent basis for overturning the rejection of claim 1.

a. Combination of references fails to teach each element of claim 1

Independent claim 1, the exemplary claim of this claim group, recites:

1. A system for reporting impending vehicle deliveries, comprising:
 - memory storing a vehicle schedule, said *vehicle schedule identifying packages that are to be respectively delivered to a plurality of recipients by a vehicle* during a first time period and *indicating an order that said vehicle is expected to deliver said packages*;
 - a first communications device configured to establish communication with remote communications devices; and
 - a *system manager configured to* analyze said vehicle schedule and to *determine, based on said order, a second time period that said vehicle is expected to deliver one of said packages*, said *system manager further configured to transmit a notification message for a respective one of said recipients of said one of said packages* via said first communications device, said notification message identifying said second time period, wherein said second time period is within said first time period.

(*Emphasis added*). Applicant respectfully asserts that the rejection of claim 1 is improper because, even if the teachings of the references were properly combinable, such combination would not result in Applicant's claimed invention. For obviousness rejections under 35 U.S.C. § 103, the prior art when combined must teach or suggest all the limitations of the rejected claim. *See Pfaff v. Wells Elecs.*, 124 F.3d 1429, 1437 (Fed. Cir. 1997). As provided above, Applicant's independent claim 1 recites a system comprising a system manager configured to analyze a vehicle schedule that identifies packages that are to be delivered to the respective recipients of the packages in a certain order by a vehicle.

The proposed combination of *Schmier* in view of *Dlugos* and Applicant's disclosure, if proper, would not result in the claimed system for at least the reason that neither *Schmier*, *Dlugos*, nor Applicant's "Related Art" disclose, teach or suggest the features of (1) a "vehicle schedule identifying packages that are to be respectively delivered to a plurality of recipients by a vehicle," (2) a "vehicle schedule ... indicating an order that said vehicle is expected to deliver said packages," (3) a "system manager configured to ... determine, based on said order, a second time period that said vehicle is expected to deliver one of said packages," or (4) a "system manager further configured to transmit a notification message for a respective one of said recipients of said one of said packages," as recited in claim 1. *Schmier* appears to disclose a system for notifying passengers in a transit system about the status of transit vehicles, vehicles which stop at predetermined transit stops regardless of the identity or quantity of the passengers on board. Abstract. Accordingly, *Schmier* suggests an approach for reporting the arrival of the vehicle itself and not the individual passengers on board the vehicle. And although *Schmier* discloses notifications in a mass transit setting, it does not disclose or suggest their use in the

context of an individual package recipient. The mass transit system of *Schmier* does not account for intended recipients of its cargo, because the cargo primarily comprises people who reach their final destination on their own.

Similarly, the limitations of claim 1 that are not found in *Schmier* are also not found within *Dlugos* or within Applicant's disclosure. *Dlugos* appears to disclose a method of transporting a parcel together with parcel information using an attached integrated circuit card. Col. 16, lines 22-25. *Dlugos* makes no reference to a vehicle in which a parcel is transported, and does not determine an order of delivery for parcels, and does not then use that order to determine a more specific time period during which the vehicle is expected to deliver one of the parcels. Furthermore, *Dlugos* fails to disclose or suggest the feature of notification messages sent to individual parcel recipients. Additionally, Applicant's "Related Art" disclosure does not teach or suggest the feature of identifying a plurality of packages to be delivered by a vehicle, determining an order of package delivery, determining, based on that order, a more specific time during which the package is expected to be delivered, or transmitting a notification message to a package recipient.

Ultimately, the unlikely extensive combination of *Schmier*, *Dlugos*, and Applicant's "Related Art" does not disclose, teach or suggest many of the features of claim 1. The missing features comprise at least (1) a "vehicle schedule identifying packages that are to be respectively delivered to a plurality of recipients by a vehicle," (2) a "vehicle schedule ... indicating an order that said vehicle is expected to deliver said packages," (3) a "system manager configured to ... determine, based on said order, a second time period that said vehicle is expected to deliver one of said packages," and (4) a "system manager further configured to transmit a notification message for a respective one of said recipients of said one of said packages." Applicant asserts

that, due to the absent elements, the combination of the proposed references would not result in the invention of claim 1, and that its rejection was therefore improper and should be overturned.

b. Schmier is not analogous prior art

Applicant asserts that it is improper to use *Schmier* as prior art against the invention because the reference is not analogous prior art, and therefore its use in the rejection of claim 1 under 35 U.S.C. § 103 is inappropriate and should be overturned. Prior art is analogous if (1) the art is from the same field of endeavor as the claimed invention, or, if from a separate field of endeavor, (2) the reference is still “reasonably pertinent” to the particular problem with which the inventor is involved. *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992). “A reference is reasonably pertinent if ... it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” *Id.*

Schmier is not from the same field of endeavor as the claimed invention since it relates to public transit passenger information systems, whereas the present invention relates to package delivery notification systems. In *Clay*, the Federal Circuit held that although a reference and the claimed invention both related to the petroleum industry, this alone was not enough for them to be considered within the same field of endeavor. *Id.* Here, the reference and Applicant’s invention are not even from the same industry. The invention of claim 1 relates to notifying a package recipient as to when to expect delivery based on the order of a vehicle’s deliveries. *Schmier*, on the other hand, relates to updating schedule information on display units and telephone and computer information systems for riders of a mass transit system. Col. 3, lines 13-29. Although the two include vehicles and schedules, the fields are dissimilar in that one relates to moving people

between predetermined stops, and the other relates to moving packages to a plurality of recipient premises.

Schmier is not “reasonably pertinent” to the particular problem with which the inventor of claim 1 is involved since the two inventions have unrelated purposes. “If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem. ... If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.” *Clay*, 966 F.2d at 659. The purposes of the invention of claim 1 include at least “reporting package deliveries and ... more precisely notifying a recipient of when to expect delivery of a package.” Specification, p. 3, lines 5-7. This is at least intended to prevent missed deliveries of packages when the recipient may not be available or to prevent packages from being left unattended. Specification, p. 2, lines 17-20, p. 3, lines 1-4. *Schmier*, however, is intended to enhance the usefulness of accurate predictions of transit vehicle arrival times, to diminish unnecessary passenger waiting time, to efficiently manage vehicle distribution in a transit system, to deliver timely instructions to transit vehicle drivers, and to deliver news and advertisements to passengers. Col. 1, lines 56-59, Col. 2, lines 49-67, Col. 3, lines 1-9. Clearly, the purposes of claim 1 would not have provided motivation or occasion for the Applicant to consider the *Schmier* reference as analogous art because of *Schmier*’s apparently divergent purposes.

The Action inappropriately argues that *Schmier* is analogous art, stating, “[s]ince package delivery and passenger delivery are similar in intent and purpose, applying the techniques and procedures to each are intuitive as well as cross-functional.” Action, p. 3. Merely stating that they are similar in purpose is not sufficient explanation and, frankly, is incorrect. As shown above, the intended purposes of both systems are divergent and would not have led an inventor of one to consider the other. Hence, the rejection of claim 1 is inappropriate for the additional reason that the

combination of references proposed by the Action includes a reference (i.e., *Schmier*) that is not available as prior art under 35 U.S.C. § 103. Applicant asserts that the rejection of claim 1 should therefore be overturned.

c. **No suggestion or motivation to combine *Schmier*, *Dlugos*, and Applicant's disclosure**

Even if *Schmier* were deemed analogous art, the Action fails to make a *prima facie* case of obviousness because the Action fails to establish the suggestion or motivation to combine the references in the manner suggested. Regardless of whether all claim elements are present in the prior art, the Patent Office has the burden of establishing that there was some motivation to combine or modify the teachings of the prior art to meet the claim limitations. *See In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984). Moreover, the Patent Office must not use conclusory statements in making its *prima facie* case. *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002). “Reasoned findings are critical to the performance of agency functions.” *Id.* The Action attempts to provide several overly broad “motivations” for why it would be obvious to combine *Schmier* with *Dlugos* and Applicant’s disclosure: “providing a more efficient delivery to the customer,” “the value to the customer is increased,” and, quoting *Dlugos*, “ ‘provides a more convenient and efficient form in which to transport information related to and accompanying parcels’ and ‘a more convenient form in which to store information relating to the contents of a storage location for goods.’ ” Action, pp. 4-6. These “motivations” amount to no more than “conclusory statements” and improper hindsight *post facto* rationalizations on the part of the Action. Ultimately, it is the prior art itself, and not the hindsight use of Applicant’s achievement, that must establish the obviousness of the combination. *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998).

There is no motivation or suggestion within the text of *Schmier* to add the parcel information system disclosed in *Dlugos*. Nor does *Schmier* even suggest a need for *Dlugos*' system for transporting accompanying information with a parcel. This is reinforced by the fact that both references serve completely divergent purposes. *See supra* Part A.1.b. The Federal Circuit has recently found that the motivation or suggestion to combine is strongest when it comes from the text of the prior art itself. *See In re Thrift*, 298 F.3d 1357, 1364 (Fed. Cir. 2002) (finding motivation in prior art language suggesting use of speech recognition in computer interface). Here, the Action's conclusory statements of efficiency, convenience, and customer value do not cure the lack of a suggestion or motivation to combine in either *Schmier* or *Dlugos*.

Moreover, even if there were a suggestion to combine *Schmier* with *Dlugos* and Applicant's disclosure in the manner suggested by the Action, the resulting combination would certainly frustrate the purposes of the references. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *Gordon*, 733 F.2d at 902. Ignoring the fact that not every element of claim 1 is found in the references, (*See infra* Part A.1.a.) if *Schmier* were modified by combining it with the other references cited, *Schmier*'s intended purpose would be frustrated. Specifically, "notifying a passenger waiting for a public transit vehicle of the arrival time of the vehicle at a public stop" where the "[v]ehicle 12 is scheduled to stop at one or more public transit stops 20 located on its route," would be inoperable in the new combination because the parcel information system of *Dlugos* and the package delivery system of Applicant's "Related Art" do not make public transit stops. *See Schmier*, col. 3, lines 13-15; col. 9, lines 23-25. Assuming *arguendo* that the alleged motivation to combine the references was proper, the proposed combination of *Schmier*, *Dlugos* and Applicant's disclosure still would not result in the invention of claim 1.

Hence, for at least the above independent reasons, the rejection of exemplary claim 1 should be overturned.

2. **Discussion of Group B: Claims 24 - 27 are patentable over *Schmier*, *Dlugos*, and Applicant's own disclosure**

The Office Action rejected claim 24 (the exemplary claim) under 35 U.S.C. § 103(a) as being unpatentable over *Schmier* in view of *Dlugos* and Applicant's own disclosure. Applicant requests that the rejection of claim 24 be overturned and submits that the rejection was improper for at least the reasons that (a) the combination of references fails to teach each and every element of claim 24, (b) the *Schmier* reference is not analogous art for purposes of 35 U.S.C. § 103, and (c) the references cited offer no suggestion or motivation for their combination. Each of these reasons are distinct and will serve as an independent basis for overturning the rejection of claim 24.

a. **Combination of references fails to teach each element of claim 24**

Independent claim 24, the exemplary claim of this claim group, recites:

24. A system for reporting impending vehicle deliveries, comprising:
means for receiving a plurality of packages;
means for assigning each of said packages to a vehicle;
means for determining an order that said vehicle is to deliver said packages;
means for determining, based on said order, a first time period that said vehicle is expected to deliver one of said packages to a recipient;
means for causing a notification message to be transmitted to said recipient, said notification message indicating said first time period;
means for simultaneously transporting each of said packages via said vehicle; and

means for transporting said one package to a premises of said recipient via said vehicle.

(*Emphasis added*). Applicant respectfully asserts that the rejection of claim 24 is improper because, even if the teachings of the references were properly combinable, such combination would not result in Applicant's claimed invention. For obviousness rejections under 35 U.S.C. § 103, the prior art when combined must teach or suggest all the limitations of the rejected claim. *See Pfaff v. Wells Elecs.*, 124 F.3d 1429, 1437 (Fed. Cir. 1997). As provided above, Applicant's independent claim 24 recites a system comprising means for determining an order that a vehicle is to deliver a plurality of packages, means for determining a time period during which the vehicle is expected to deliver a package to a recipient, as well as means for causing a notification message to be transmitted to the recipient informing the recipient of the time period.

The proposed combination of *Schmier* in view of *Dlugos* and Applicant's disclosure, if proper, would not result in the claimed system for at least the reason that neither *Schmier*, *Dlugos*, nor Applicant's "Related Art" disclose, teach or suggest the features of (1) "means for determining an order that said vehicle is to deliver said packages," (2) "means for determining, based on said order, a first time period that said vehicle is expected to deliver one of said packages to a recipient," or (3) "means for causing a notification message to be transmitted to said recipient, said notification message indicating said first time period," as recited in claim 24. *Schmier* appears to disclose a system for notifying passengers (not package recipients) in a transit system about the status of transit vehicles, vehicles which stop at predetermined transit stops regardless of the identity or quantity of the passengers on board. Abstract. Accordingly, *Schmier* suggests an approach for scheduling the arrival of the vehicle itself and not the individual passengers on board the vehicle. And although *Schmier* discloses notifications in a mass transit

setting, it does not disclose or suggest their use in the context of an individual package recipient.

The mass transit system of *Schmier* does not account for intended recipients of its cargo, because the cargo primarily comprises people who reach their final destination on their own.

Similarly, the features of claim 24 that are not found in *Schmier* are also not found within *Dlugos* or within Applicant's "Related Art" disclosure. *Dlugos* appears to disclose a method of transporting a parcel together with parcel information using an attached integrated circuit card. Col. 16, lines 22-25. *Dlugos* makes no reference to using a vehicle's order of delivery to determine a more specific time period during which the vehicle is expected to deliver one of the parcels. Furthermore, *Dlugos* fails to disclose or suggest notification messages sent to individual parcel recipients. And even though Applicant's "Related Art" disclosure, cited in the Action, may reference guaranteed delivery times of packages, there is no reference made to determining, based on a package delivery order, a more specific time during which the package is expected to be delivered. Specification, p. 2, lines 1-4.

Ultimately, the unlikely extensive combination of *Schmier*, *Dlugos*, and Applicant's "Related Art" does not disclose, teach or suggest many of the features of claim 24. The missing features comprise at least "means for determining, based on said order, a first time period that said vehicle is expected to deliver one of said packages to a recipient," and "means for causing a notification message to be transmitted to said recipient, said notification message indicating said first time period." Applicant asserts that, due to the absent elements, the combination of the proposed references would not result in the invention of claim 24, and that its rejection was therefore improper and should be overturned.

b. **Schmier is not analogous prior art**

Applicant respectfully reasserts the arguments of Part A.1.b., alleging that it is improper to use *Schmier* as prior art against the invention because the reference is not analogous prior art, and therefore its use in the rejection of claim 24 under 35 U.S.C. § 103 is inappropriate and should be overturned.

c. **No suggestion or motivation to combine *Schmier*, *Dlugos*, and Applicant's disclosure**

Even if *Schmier* were deemed analogous art for the sake of argument, the Patent Office has not made a *prima facie* case of obviousness because the Action fails to establish the suggestion or motivation to combine the references in the manner suggested. Regardless of whether all claim elements are present in the prior art, the Patent Office has the burden of establishing that there was some motivation to combine or modify the teachings of the prior art to meet the claim limitations. *See Gordon*, 733 F.2d at 902. Moreover, the Patent Office must not use conclusory statements in making its *prima facie* case. *Lee*, 277 F.3d at 1344. "Reasoned findings are critical to the performance of agency functions." *Id.* The Action attempts to provide several overly broad "motivations" for why it would be obvious to combine *Schmier* with *Dlugos* and Applicant's disclosure: "providing a more efficient delivery to the customer," "the value to the customer is increased," and, quoting *Dlugos*, " 'provides a more convenient and efficient form in which to transport information related to and accompanying parcels' and 'a more convenient form in which to store information relating to the contents of a storage location for goods.' " Action, pp. 4-6. These "motivations" amount to no more than "conclusory statements" and improper hindsight *post facto* rationalizations on the part of the Action. Ultimately, it is the

prior art itself, and not the hindsight use of Applicant's achievement, that must establish the obviousness of the combination. *Dance*, 160 F.3d at 1343.

There is no motivation or suggestion within the text of *Schmier* to add the parcel information system disclosed in *Dlugos*. Nor does *Schmier* even suggest a need for *Dlugos*' system for transporting accompanying information with a parcel. This is reinforced by the fact that both references serve completely divergent purposes. *See supra* Part A.2.b. The Federal Circuit has recently found that the motivation or suggestion to combine is strongest when it comes from the text of the prior art itself. *See Thrift*, 298 F.3d at 1364 (finding motivation in prior art language suggesting use of speech recognition in computer interface). Here, the Action's conclusory statements of efficiency, convenience, and customer value do not cure the lack of a suggestion or motivation to combine in either *Schmier* or *Dlugos*.

Moreover, even if there were a suggestion to combine *Schmier* with *Dlugos* and Applicant's disclosure in the manner suggested by the Action, the resulting combination would certainly frustrate the purposes of the references. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *Gordon*, 733 F.2d at 902. Ignoring the fact that not every element of claim 1 is found in the references, (*See infra* Part A.2.a.) if *Schmier* were modified by combining it with the other references cited, *Schmier*'s intended purpose would be frustrated. Specifically, "notifying a passenger waiting for a public transit vehicle of the arrival time of the vehicle at a public stop" where the "[v]ehicle 12 is scheduled to stop at one or more public transit stops 20 located on its route," would be inoperable in the new combination because the parcel information system of *Dlugos* and the package delivery system of Applicant's "Related Art" do not make public transit stops. *See Schmier*, col. 3, lines 13-15; col.

9, lines 23-25. Assuming *arguendo* that the alleged motivation to combine the references was proper, the proposed combination of *Schmier*, *Dlugos* and Applicant's disclosure still would not result in the invention of claim 24. Hence, for at least the above independent reasons, the rejection of exemplary claim 24 should be overturned.

B. Issue Two

1. Discussion of Group C: Claims 5-7, 9, and 10 are patentable over *Schmier*, *Dlugos*, Applicant's disclosure, and Hitchcock

The Office Action rejected claim 5 (the exemplary claim) under 35 U.S.C. § 103(a) as being unpatentable over *Schmier* in view of *Dlugos*, Applicant's disclosure, and Hitchcock. Applicant requests that the rejection of claim 5 be overturned and submits that the rejection was improper for at least the reasons that the *Schmier* reference is not analogous art for purposes of 35 U.S.C. § 103, and the references cited offer no suggestion or motivation for their combination. Each of these reasons are distinct and will serve as an independent basis for overturning the rejection of claim 5.

a. *Schmier* is not analogous prior art

Applicant respectfully reasserts the arguments of Part A.1.b., alleging that it is improper to use *Schmier* as prior art against the invention because the reference is not analogous prior art, and therefore its use in the rejection of claim 5 under 35 U.S.C. § 103 is inappropriate and should be overturned.

b. No suggestion or motivation to combine *Schmier*, *Dlugos*, Applicant's disclosure, and Hitchcock

Even if *Schmier* were deemed analogous art for the sake of argument, the Patent Office has not made a *prima facie* case of obviousness because the Action fails to establish the suggestion or motivation to combine the references in the manner suggested. The Patent Office has the burden of establishing that there was some motivation to combine or modify the teachings of the prior art to meet the claim limitations. *See Gordon*, 733 F.2d at 902. Moreover, the Patent Office must not use conclusory statements in making its *prima facie* case. *Lee*, 277 F.3d at 1344. “Reasoned findings are critical to the performance of agency functions.” *Id.* The Action attempts to provide several overly broad “motivations” for why it would be obvious to combine *Schmier* with *Dlugos*, Applicant’s disclosure, and Hitchcock: “improving customer satisfaction and overall efficiency,” “accuracy in delivery is increased which improves customer satisfaction,” and, quoting *Dlugos*, “ ‘provides a more convenient and efficient form in which to transport information related to and accompanying parcels’ and ‘a more convenient form in which to store information relating to the contents of a storage location for goods.’ ” Action, pp. 9-11. These “motivations” amount to no more than “conclusory statements” and improper hindsight *post facto* rationalizations on the part of the Action. Ultimately, it is the prior art itself, and not the hindsight use of Applicant’s achievement, that must establish the obviousness of the combination. *Dance*, 160 F.3d at 1343.

There is no motivation or suggestion within the text of *Schmier* to add the parcel information system disclosed in *Dlugos*, or the bar-code-based warehouse management system of Hitchcock. *Schmier* does not even suggest a need for *Dlugos*’ system for transporting accompanying information with a parcel, or Hitchcock’s system for tracking orders in a

warehouse setting. This is reinforced by the fact that the references serve completely divergent purposes. The Federal Circuit has recently found that the motivation or suggestion to combine is strongest when it comes from the text of the prior art itself. *See Thrift*, 298 F.3d at 1364 (finding motivation in prior art language suggesting use of speech recognition in computer interface). Here, the Action's conclusory statements of efficiency, convenience, and customer value do not cure the lack of a suggestion or motivation to combine in either *Schmier*, *Dlugos*, or Hitchcock.

Moreover, even if there were a suggestion to combine *Schmier* with *Dlugos*, Applicant's disclosure, and Hitchcock in the manner suggested by the Action, the resulting combination would certainly frustrate the purposes of the references. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *Gordon*, 733 F.2d at 902. If *Schmier* were modified by combining it with the other references cited, *Schmier*'s intended purpose would be frustrated. Specifically, "notifying a passenger waiting for a public transit vehicle of the arrival time of the vehicle at a public stop" where the "[v]ehicle 12 is scheduled to stop at one or more public transit stops 20 located on its route," would be inoperable in the new combination because the parcel information system of *Dlugos*, the package delivery system of Applicant's "Related Art", and the warehouse management system of Hitchcock do not make public transit stops. Instead, these references appear to involve the delivery of packages and orders to a customer's premises. *See Schmier*, col. 3, lines 13-15; col. 9, lines 23-25. Furthermore, affixing *Dlugos*' integrated circuit chips or Hitchcock's bar codes to *Schmier*'s passengers would likely subvert *Schmier*'s purported goal of increasing customer satisfaction since public transit passengers would likely be dissatisfied at having to affix tracking devices

onto their persons. Hence, for at least the above independent reasons, the rejection of exemplary claim 5 should be overturned.

2. **Discussion of Group D: Claims 12-15 are patentable over *Schmier*, *Dlugos*, Applicant's disclosure, and Hitchcock**

The Office Action rejected claim 12 (the exemplary claim) under 35 U.S.C. § 103(a) as being unpatentable over *Schmier* in view of *Dlugos*, Applicant's disclosure, and Hitchcock. Applicant requests that the rejection of claim 12 be overturned and submits that the rejection was improper for at least the reasons that the combination of references fails to teach each and every element of claim 12, the *Schmier* reference is not analogous art for purposes of 35 U.S.C. § 103, and the references cited offer no suggestion or motivation for their combination. Each of these reasons are distinct and will serve as independent bases for overturning the rejection of claim 12.

a. **Combination of references fails to teach each step of claim 12**

Independent claim 12, the exemplary claim of this claim group, recites:

12. A method for reporting impending vehicle deliveries, comprising the steps of:
receiving a plurality of packages;
assigning each of said packages to a vehicle;
determining an order that said vehicle is to deliver said packages;
determining, based on said order, a first time period that said vehicle is expected to deliver one of said packages to a recipient;
causing a notification message to be transmitted to said recipient based on said determining a first time period step;
indicating said first time period via said notification message;
simultaneously transporting each of said packages via said vehicle; and

transporting said one package to a premises of said recipient via said vehicle.

(*Emphasis added*). Applicant respectfully asserts that the rejection of claim 12 is improper because, even if the teachings of the references were properly combinable, such combination would not result in Applicant's claimed invention. For obviousness under 35 U.S.C. § 103, the prior art when combined must teach or suggest all the limitations of the rejected claim. *See Pfaff v. Wells Elecs.*, 124 F.3d 1429, 1437 (Fed. Cir. 1997). As provided above, Applicant's independent claim 12 recites a method comprising the steps of determining an order that a vehicle will deliver packages, determining a time period, based on that order, during which the vehicle is expected to deliver one of the packages, and indicating the time period in a notification message to a recipient of the package.

The proposed combination of *Schmier* in view of *Dlugos*, Applicant's disclosure, and Hitchcock, if proper, would not result in the claimed method for at least the reason that neither *Schmier*, *Dlugos*, Applicant's "Related Art", nor Hitchcock disclose, teach or suggest the steps of (1) "determining an order that said vehicle is to deliver said packages," (2) "determining, based on said order, a first time period that said vehicle is expected to deliver one of said packages to a recipient," or (3) "indicating said first time period via said notification message," as recited in claim 12.

Schmier appears to disclose a system for notifying passengers (not package recipients) in a transit system about the status of transit vehicles, vehicles which stop at predetermined transit stops regardless of the identity or quantity of the passengers on board. Abstract. Accordingly, *Schmier* suggests an approach for scheduling the arrival of the vehicle itself and not the individual passengers on board the vehicle. And although *Schmier* discloses notifications in a

mass transit setting, it does not disclose or suggest their use in the context of an individual package recipient. The mass transit system of *Schmier* does not account for intended recipients of its cargo, because the cargo primarily comprises people who reach their final destination on their own.

Similarly, the features of claim 12 that are not found in *Schmier* are also not found within *Dlugos*, Applicant's "Related Art," or Hitchcock. *Dlugos* appears to disclose a method of transporting a parcel together with parcel information using an attached integrated circuit card. Col. 16, lines 22-25. *Dlugos* makes no reference to using a vehicle's order of delivery to determine a more specific time period during which the vehicle is expected to deliver one of the parcels. Furthermore, *Dlugos* fails to disclose or suggest notification messages sent to individual parcel recipients. And even though Applicant's "Related Art" disclosure, cited in the Action, may reference guaranteed delivery times of packages, there is no reference made to determining, based on a package delivery order, a more specific time during which the package is expected to be delivered. Specification, p. 2, lines 1-4. Finally, Hitchcock fails to disclose, teach or even suggest the use of a vehicle's delivery order to transmit a notification message giving a more specific time period during which the vehicle is expected to deliver a package.

Ultimately, the unlikely combination of *Schmier*, *Dlugos*, Applicant's "Related Art," and Hitchcock does not disclose, teach or suggest many of the steps of claim 12. The missing steps comprise at least "determining an order that said vehicle is to deliver said packages," "determining, based on said order, a first time period that said vehicle is expected to deliver one of said packages to a recipient," and "indicating said first time period via said notification message." Applicant asserts that, due to the absent elements, the proposed combination of

references would not result in the invention of claim 12, and that its rejection was therefore improper and should be overturned.

b. Schmier is not analogous prior art

Applicant respectfully reasserts the arguments of Part A.1.b., alleging that it is improper to use *Schmier* as prior art against the invention because the reference is not analogous prior art, and therefore its use in the rejection of claim 12 under 35 U.S.C. § 103 is inappropriate and should be overturned.

c. No suggestion or motivation to combine *Schmier*, *Dlugos*, Applicant's disclosure, and Hitchcock

Even if *Schmier* were deemed analogous art for the sake of argument, the Patent Office has not made a *prima facie* case of obviousness because the Action fails to establish the suggestion or motivation to combine the references in the manner suggested. The Patent Office has the burden of establishing that there was some motivation to combine or modify the teachings of the prior art to meet the claim limitations. *See Gordon*, 733 F.2d at 902. Moreover, the Patent Office must not use conclusory statements in making its *prima facie* case. *Lee*, 277 F.3d at 1344. "Reasoned findings are critical to the performance of agency functions." *Id.* The Action attempts to provide several overly broad "motivations" for why it would be obvious to combine *Schmier* with *Dlugos*, Applicant's disclosure, and Hitchcock: "a more efficient delivery," "accuracy in delivery is increased which improves customer satisfaction," and, quoting *Dlugos*, "'provides a more convenient and efficient form in which to transport information related to and accompanying parcels' and 'a more convenient form in which to store information

relating to the contents of a storage location for goods.’ ” Action, pp. 15-17. These “motivations” amount to no more than “conclusory statements” and improper hindsight *post facto* rationalizations on the part of the Action. Ultimately, it is the prior art itself, and not the hindsight use of Applicant’s achievement, that must establish the obviousness of the combination. *Dance*, 160 F.3d at 1343.

There is no motivation or suggestion within the text of *Schmier* to add the parcel information system disclosed in *Dlugos*, or the bar-code-based warehouse management system of Hitchcock. *Schmier* does not even suggest a need for *Dlugos*’ system for transporting accompanying information with a parcel, or Hitchcock’s system for tracking orders in a warehouse setting. This is reinforced by the fact that the references serve completely divergent purposes. The Federal Circuit has recently found that the motivation or suggestion to combine is strongest when it comes from the text of the prior art itself. *See Thrift*, 298 F.3d at 1364 (finding motivation in prior art language suggesting use of speech recognition in computer interface). Here, the Action’s conclusory statements of efficiency, convenience, and customer value do not cure the lack of a suggestion or motivation to combine in either *Schmier*, *Dlugos*, or Hitchcock.

Moreover, even if there were a suggestion to combine *Schmier* with *Dlugos*, Applicant’s disclosure, and Hitchcock in the manner suggested by the Action, the resulting combination would certainly frustrate the purposes of the references. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *Gordon*, 733 F.2d at 902. If *Schmier* were modified by combining it with the other references cited, *Schmier*’s intended purpose would be frustrated. Specifically, “notifying a passenger waiting for a public transit vehicle of the arrival time of the vehicle at a public stop” where the “[v]ehicle 12 is scheduled to

stop at one or more public transit stops 20 located on its route,” would be inoperable in the new combination because the parcel information system of *Dlugos*, the package delivery system of Applicant’s “Related Art”, and the warehouse management system of Hitchcock do not make public transit stops. Instead, these references appear to involve the delivery of packages and orders to a customer’s premises. *See Schmier*, col. 3, lines 13-15; col. 9, lines 23-25. Furthermore, affixing *Dlugos*’ integrated circuit chips or Hitchcock’s bar codes to *Schmier*’s passengers would likely subvert *Schmier*’s purported goal of increasing customer satisfaction since public transit passengers would likely be dissatisfied at having to affix tracking devices onto their persons. Hence, for at least the above independent reasons, the rejection of exemplary claim 5 should be overturned.

3. **Discussion of Group E: Claims 16-19, and 21 are patentable over *Schmier*, *Dlugos*, Applicant’s disclosure, and Hitchcock**

The Office Action rejected claim 16 (the exemplary claim) under 35 U.S.C. § 103(a) as being unpatentable over *Schmier* in view of *Dlugos*, Applicant’s disclosure, and Hitchcock. Applicant requests that the rejection of claim 16 be overturned and submits that the rejection was improper for at least the reasons that the *Schmier* reference is not analogous art for purposes of 35 U.S.C. § 103, and the references cited offer no suggestion or motivation for their combination. Each of these reasons are distinct and will serve as an independent basis for overturning the rejection of claim 16.

a. **Schmier is not analogous prior art**

Applicant respectfully reasserts the arguments of Part A.1.b., alleging that it is improper to use *Schmier* as prior art against the invention because the reference is not analogous prior art, and therefore its use in the rejection of claim 16 under 35 U.S.C. § 103 is inappropriate and should be overturned.

b. **No suggestion or motivation to combine *Schmier*, *Dlugos*, Applicant's disclosure, and Hitchcock**

Even if *Schmier* were deemed analogous art for the sake of argument, the Patent Office has not made a *prima facie* case of obviousness because the Action fails to establish the suggestion or motivation to combine the references in the manner suggested. The Patent Office has the burden of establishing that there was some motivation to combine or modify the teachings of the prior art to meet the claim limitations. *See Gordon*, 733 F.2d at 902. Moreover, the Patent Office must not use conclusory statements in making its *prima facie* case. *Lee*, 277 F.3d at 1344. "Reasoned findings are critical to the performance of agency functions." *Id.* The Action attempts to provide several overly broad "motivations" for why it would be obvious to combine *Schmier* with *Dlugos*, Applicant's disclosure, and Hitchcock: "improving customer satisfaction and overall efficiency," "accuracy in delivery is increased which improves customer satisfaction," "provides good customer service by saving the recipient time," and, quoting *Dlugos*, " 'provides a more convenient and efficient form in which to transport information related to and accompanying parcels' and 'a more convenient form in which to store information relating to the contents of a storage location for goods.' " Action, pp. 20-23. These "motivations" amount to no more than "conclusory statements" and improper hindsight *post*

facto rationalizations on the part of the Action. Ultimately, it is the prior art itself, and not the hindsight use of Applicant's achievement, that must establish the obviousness of the combination. *Dance*, 160 F.3d at 1343.

There is no motivation or suggestion within the text of *Schmier* to add the parcel information system disclosed in *Dlugos*, or the bar-code-based warehouse management system of Hitchcock. *Schmier* does not even suggest a need for *Dlugos*' system for transporting accompanying information with a parcel, or Hitchcock's system for tracking orders in a warehouse setting. This is reinforced by the fact that the references serve completely divergent purposes. The Federal Circuit has recently found that the motivation or suggestion to combine is strongest when it comes from the text of the prior art itself. *See Thrift*, 298 F.3d at 1364 (finding motivation in prior art language suggesting use of speech recognition in computer interface). Here, the Action's conclusory statements of efficiency, convenience, and customer value do not cure the lack of a suggestion or motivation to combine in either *Schmier*, *Dlugos*, or Hitchcock.

Moreover, even if there were a suggestion to combine *Schmier* with *Dlugos*, Applicant's disclosure, and Hitchcock in the manner suggested by the Action, the resulting combination would certainly frustrate the purposes of the references. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *Gordon*, 733 F.2d at 902. If *Schmier* were modified by combining it with the other references cited, *Schmier*'s intended purpose would be frustrated. Specifically, "notifying a passenger waiting for a public transit vehicle of the arrival time of the vehicle at a public stop" where the "[v]ehicle 12 is scheduled to stop at one or more public transit stops 20 located on its route," would be inoperable in the new combination because the parcel information system of *Dlugos*, the package delivery system of

Applicant's "Related Art", and the warehouse management system of Hitchcock do not make public transit stops. Instead, these references appear to involve the delivery of packages and orders to a customer's premises. *See Schmier*, col. 3, lines 13-15; col. 9, lines 23-25. Furthermore, affixing *Dlugos*' integrated circuit chips or Hitchcock's bar codes to *Schmier*'s passengers would likely subvert *Schmier*'s purported goal of increasing customer satisfaction since public transit passengers would likely be dissatisfied at having to affix tracking devices onto their persons. Hence, for at least the above independent reasons, the rejection of exemplary claim 16 should be overturned.

4. **Discussion of Group F: Claims 28, 29, 31, and 33 are patentable over *Schmier*, *Dlugos*, Applicant's disclosure, and Hitchcock**

The Office Action rejected claim 28 (the exemplary claim) under 35 U.S.C. § 103(a) as being unpatentable over *Schmier* in view of *Dlugos*, Applicant's disclosure, and Hitchcock. Applicant requests that the rejection of claim 28 be overturned and submits that the rejection was improper for at least the reasons that the *Schmier* reference is not analogous art for purposes of 35 U.S.C. § 103, and the references cited offer no suggestion or motivation for their combination. Each of these reasons are distinct and will serve as an independent basis for overturning the rejection of claim 28.

a. ***Schmier* is not analogous prior art**

Applicant respectfully reasserts the arguments of Part A.1.b., alleging that it is improper to use *Schmier* as prior art against the invention because the reference is not analogous prior art, and

therefore its use in the rejection of claim 28 under 35 U.S.C. § 103 is inappropriate and should be overturned.

b. **No suggestion or motivation to combine *Schmier*, *Dlugos*, Applicant's disclosure, and Hitchcock**

Even if *Schmier* were deemed analogous art for the sake of argument, the Patent Office has not made a *prima facie* case of obviousness because the Action fails to establish the suggestion or motivation to combine the references in the manner suggested. The Patent Office has the burden of establishing that there was some motivation to combine or modify the teachings of the prior art to meet the claim limitations. *See Gordon*, 733 F.2d at 902. Moreover, the Patent Office must not use conclusory statements in making its *prima facie* case. *Lee*, 277 F.3d at 1344. “Reasoned findings are critical to the performance of agency functions.” *Id.* The Action attempts to provide several overly broad “motivations” for why it would be obvious to combine *Schmier* with *Dlugos*, Applicant’s disclosure, and Hitchcock: “improving customer satisfaction and overall efficiency,” “accuracy in delivery is increased which improves customer satisfaction,” and, quoting *Dlugos*, “ ‘provides a more convenient and efficient form in which to transport information related to and accompanying parcels’ and ‘a more convenient form in which to store information relating to the contents of a storage location for goods.’ ” Action, pp. 9-11. These “motivations” amount to no more than “conclusory statements” and improper hindsight *post facto* rationalizations on the part of the Action. Ultimately, it is the prior art itself, and not the hindsight use of Applicant’s achievement, that must establish the obviousness of the combination. *Dance*, 160 F.3d at 1343.

There is no motivation or suggestion within the text of *Schmier* to add the parcel information system disclosed in *Dlugos*, or the bar-code-based warehouse management system of Hitchcock. *Schmier* does not even suggest a need for *Dlugos*' system for transporting accompanying information with a parcel, or Hitchcock's system for tracking orders in a warehouse setting. This is reinforced by the fact that the references serve completely divergent purposes. The Federal Circuit has recently found that the motivation or suggestion to combine is strongest when it comes from the text of the prior art itself. *See Thrift*, 298 F.3d at 1364 (finding motivation in prior art language suggesting use of speech recognition in computer interface). Here, the Action's conclusory statements of efficiency, convenience, and customer value do not cure the lack of a suggestion or motivation to combine in either *Schmier*, *Dlugos*, or Hitchcock.

Moreover, even if there were a suggestion to combine *Schmier* with *Dlugos*, Applicant's disclosure, and Hitchcock in the manner suggested by the Action, the resulting combination would certainly frustrate the purposes of the references. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *Gordon*, 733 F.2d at 902. If *Schmier* were modified by combining it with the other references cited, *Schmier*'s intended purpose would be frustrated. Specifically, "notifying a passenger waiting for a public transit vehicle of the arrival time of the vehicle at a public stop" where the "[v]ehicle 12 is scheduled to stop at one or more public transit stops 20 located on its route," would be inoperable in the new combination because the parcel information system of *Dlugos*, the package delivery system of Applicant's "Related Art", and the warehouse management system of Hitchcock do not make public transit stops. Instead, these references appear to involve the delivery of packages and orders to a customer's premises. *See Schmier*, col. 3, lines 13-15; col. 9, lines 23-25.

Furthermore, affixing *Dlugos*' integrated circuit chips or Hitchcock's bar codes to *Schmier*'s passengers would likely subvert *Schmier*'s purported goal of increasing customer satisfaction since public transit passengers would likely be dissatisfied at having to affix tracking devices onto their persons. Hence, for at least the above independent reasons, the rejection of exemplary claim 28 should be overturned.

C. Issue Three

1. Discussion of Group G: Claims 8 and 30 are patentable over *Schmier*, *Dlugos*, Applicant's disclosure, Hitchcock, and Bar Code

The Office Action rejected claim 8 (the exemplary claim) under 35 U.S.C. § 103(a) as being unpatentable over *Schmier* in view of *Dlugos*, Applicant's disclosure, Hitchcock, and Bar Code. Applicant requests that the rejection of claim 8 be overturned and submits that the rejection was improper for at least the reasons that the *Schmier* reference is not analogous art for purposes of 35 U.S.C. § 103, and the references cited offer no suggestion or motivation for their combination. Each of these reasons are distinct and will serve as an independent basis for overturning the rejection of claim 8.

a. *Schmier* is not analogous prior art

Applicant respectfully reasserts the arguments of Part A.1.b., alleging that it is improper to use *Schmier* as prior art against the invention because the reference is not analogous prior art, and therefore its use in the rejection of claim 8 under 35 U.S.C. § 103 is inappropriate and should be overturned.

b. No suggestion or motivation to combine *Schmier*, *Dlugos*, Applicant's disclosure, Hitchcock, and Bar Code

Even if *Schmier* were deemed analogous art, the Patent Office has not made a *prima facie* case of obviousness because the Action fails to establish the suggestion or motivation to combine the references in the manner suggested. The Patent Office has the burden of establishing that there was some motivation to combine or modify the teachings of the prior art to meet the claim limitations. *See Gordon*, 733 F.2d at 902. Moreover, the Patent Office must not use conclusory statements in making its *prima facie* case. *Lee*, 277 F.3d at 1344. "Reasoned findings are critical to the performance of agency functions." *Id.* The Action attempts to provide several overly broad "motivations" for why it would be obvious to combine *Schmier* with *Dlugos*, Applicant's disclosure, Hitchcock, and Bar Code: "increasing efficiency and productivity," "improving customer satisfaction and overall efficiency," "accuracy in delivery is increased which improves customer satisfaction," and, quoting *Dlugos*, "'provides a more convenient and efficient form in which to transport information related to and accompanying parcels' and 'a more convenient form in which to store information relating to the contents of a storage location for goods.'" Action, pp. 26, 9-11. These "motivations" amount to no more than "conclusory statements" and improper hindsight *post facto* rationalizations on the part of the Action. Ultimately, it is the prior art itself, and not the hindsight use of Applicant's achievement, that must establish the obviousness of the combination. *Dance*, 160 F.3d at 1343.

There is no motivation or suggestion within the text of *Schmier* to add the parcel information system disclosed in *Dlugos*, the warehouse management system of Hitchcock, or the bar code technology of Bar Code. *Schmier* does not even suggest a need for *Dlugos*' system for transporting accompanying information with a parcel, Hitchcock's system for tracking orders in a

warehouse setting, or any of the bar code varieties of Bar Code. This is reinforced by the fact that the references serve completely divergent purposes. The Federal Circuit has recently found that the motivation or suggestion to combine is strongest when it comes from the text of the prior art itself. *See Thrift*, 298 F.3d at 1364 (finding motivation in prior art language suggesting use of speech recognition in computer interface). Here, the Action's conclusory statements of efficiency, convenience, and customer value do not cure the lack of a suggestion or motivation to combine in either *Schmier*, *Dlugos*, or Hitchcock.

Moreover, even if there were a suggestion to combine *Schmier* with *Dlugos*, Applicant's disclosure, Hitchcock, and Bar Code in the manner suggested by the Action, the resulting combination would certainly frustrate the purposes of the references. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *Gordon*, 733 F.2d at 902. If *Schmier* were modified by combining it with the other references cited, *Schmier*'s intended purpose would be frustrated. Specifically, "notifying a passenger waiting for a public transit vehicle of the arrival time of the vehicle at a public stop" where the "[v]ehicle 12 is scheduled to stop at one or more public transit stops 20 located on its route," would be inoperable in the new combination because the parcel information system of *Dlugos*, the package delivery system of Applicant's "Related Art", the warehouse management system of Hitchcock, and the bar code technology of Bar Code do not involve making public transit stops. Instead, these references appear to involve the delivery of packages and orders to a customer's premises. *See Schmier*, col. 3, lines 13-15; col. 9, lines 23-25. Furthermore, attaching *Dlugos*' integrated circuit chips or the bar codes of Hitchcock or Bar Code to *Schmier*'s passengers would likely subvert *Schmier*'s purported goal of increasing customer satisfaction since public transit

passengers would likely be dissatisfied at having to affix tracking devices onto their persons. Hence, for at least the above independent reasons, the rejection of claim 8 should be overturned.

D. Issue Four

1. Discussion of Group H: Claims 11, 20, 32, and 37 are patentable over *Schmier*, *Dlugos*, Applicant's disclosure, and *Fruchey*

The Office Action rejected claim 11 (the exemplary claim) under 35 U.S.C. § 103(a) as being unpatentable over *Schmier* in view of *Dlugos* and Applicant's own disclosure. Applicant requests that the rejection of claim 11 be overturned and submits that the rejection was improper for at least the reasons that the combination of references fails to teach each and every element of claim 11, the *Schmier* and *Fruchey* references are not analogous art for purposes of 35 U.S.C. § 103, and the references cited offer no suggestion or motivation for their combination. Each of these reasons are distinct and will serve as an independent basis for overturning the rejection of claim 11.

a. Combination of references fails to teach each element of claim 11

Independent claim 11, the exemplary claim of this claim group, recites:

11. The system of claim 5, wherein said *system manager* is further *configured to determine when said vehicle is within a predefined proximity of a premises of said one recipient* based on signals transmitted from said vehicle, said *system manager* further *configured to transmit a second notification message when said vehicle is within said predefined proximity*.

(*Emphasis added*). Applicant respectfully asserts that the rejection of claim 11 is improper because, even if the teachings of the references were properly combinable, such combination

would not result in Applicant's claimed invention. For obviousness claim rejections under 35 U.S.C. § 103, the prior art when combined must teach or suggest all the limitations of the rejected claim. *See Pfaff v. Wells Elecs.*, 124 F.3d 1429, 1437 (Fed. Cir. 1997). As provided above, Applicant's independent claim 11 recites a system comprising a system manager configured to determine when a vehicle is within a predefined proximity of a premises of a package recipient and configured to transmit a second notification message when the vehicle is within the predefined proximity.

The proposed combination of *Schmier* in view of *Dlugos*, Applicant's disclosure, Hitchcock and *Fruchey*, if proper, would not result in the claimed system for at least the reason that neither *Schmier*, *Dlugos*, Applicant's "Related Art," Hitchcock, nor *Fruchey* disclose, teach or suggest a system manager that is (1) a "system manager ... configured to determine when said vehicle is within a predefined proximity of a premises of said one recipient," or (2) a "system manager ... configured to transmit a second notification message when said vehicle is within said predefined proximity," as recited in claim 11.

Schmier and *Fruchey* both appear to disclose systems for notifying passengers in a transit system about the status of transit vehicles, vehicles which stop at predetermined transit stops regardless of the identity or quantity of the passengers on board. Abstract(s). Accordingly, *Schmier* and *Fruchey* both suggest an approaches for reporting the arrival of the vehicle itself and not the individual passengers on board the vehicle. And although *Schmier* discloses notifications in a mass transit setting, it does not disclose or suggest their use in the context of an individual package recipient. The mass transit systems of *Schmier* and *Fruchey* do not account for intended recipients of their cargo, because the cargo primarily comprises people who reach their final destination on their own.

Similarly, the limitations of claim 11 that are not found in *Schmier* or *Fruchey* are also not found within *Dlugos*, Applicant's "Related Art," or Hitchcock. *Dlugos* appears to disclose a method of transporting a parcel together with parcel information using an attached integrated circuit card. Col. 16, lines 22-25. *Dlugos* makes no reference to determining when a vehicle is within a predefined proximity of a recipient premises. Furthermore, *Dlugos* fails to disclose or suggest the feature of notification messages sent to individual parcel recipients. Additionally, Applicant's "Related Art" disclosure does not teach or suggest such improvements. Finally, Hitchcock fails to disclose, teach or even suggest determining when a vehicle is within a predefined proximity of a recipient premises and thereafter transmitting a notification message.

Ultimately, the unlikely combination of *Schmier*, *Dlugos*, Applicant's "Related Art," Hitchcock and *Fruchey* does not disclose, teach or suggest several of the features of claim 11. The missing features comprise at least a "system manager ... configured to determine when said vehicle is within a predefined proximity of a premises of said one recipient," and a "system manager ... configured to transmit a second notification message when said vehicle is within said predefined proximity." Applicant asserts that, due to the absent elements, the combination of the proposed references would not result in the invention of claim 11, and that its rejection was therefore improper and should be overturned.

b. *Schmier* and *Fruchey* are not analogous prior art

Applicant asserts that it is improper to use either *Schmier* or *Fruchey* as prior art against the invention because the references are not analogous prior art, and therefore their use in the rejection of claim 11 under 35 U.S.C. § 103 is inappropriate and should be overturned. Prior art is analogous if (1) the art is from the same field of endeavor as the claimed invention, or, if from a separate field

of endeavor, (2) the reference is still “reasonably pertinent” to the particular problem with which the inventor is involved. *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992). “A reference is reasonably pertinent if ... it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” *Id.*

Schmier and *Fruchey* are not from the same field of endeavor as the claimed invention since they relate to public transit passenger information systems, whereas the present invention relates to package delivery notification systems. In *Clay*, the Federal Circuit held that although a reference and the claimed invention both related to the petroleum industry, this alone was not enough for them to be considered within the same field of endeavor. *Id.* Here, the reference and Applicant’s invention are not even from the same industry. The invention of claim 11 relates to notifying a package recipient as to when to expect delivery based on the order of a vehicle’s deliveries. *Schmier* relates to updating schedule information on display units and telephone and computer information systems for riders of a mass transit system. Col. 3, lines 13-29. Similarly, *Fruchey* relates to signaling transit passengers when their transportation vehicle is approaching. Col. 1, lines 44-46. Although the references and the invention relate broadly to vehicles, the fields are dissimilar in that *Schmier* and *Fruchey* relate to moving people between predetermined stops, and the invention of claim 11 relates to delivering packages to a recipient premises.

Neither *Schmier* nor *Fruchey* are “reasonably pertinent” to the particular problem with which the inventor of claim 11 is involved since their purposes are unrelated. “If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem. ... If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.” *Clay*, 966 F.2d at 659. The purposes of the invention of claim 1 include at least “reporting package deliveries and ... more precisely notifying a recipient of when to

expect delivery of a package.” Specification, p. 3, lines 5-7. This is at least intended to prevent missed deliveries of packages when the recipient may not be available or to prevent packages from being left unattended. Specification, p. 2, lines 17-20, p. 3, lines 1-4. *Schmier*, however, is intended to enhance the usefulness of accurate predictions of transit vehicle arrival times, to diminish unnecessary passenger waiting time, to efficiently manage vehicle distribution in a transit system, to deliver timely instructions to transit vehicle drivers, and to deliver news and advertisements to passengers. Col. 1, lines 56-59, Col. 2, lines 49-67, Col. 3, lines 1-9. *Fruchey* is intended simply to audibly warn passengers of the impending arrival of their bus for pick up. Col. 1, lines 35-41. Clearly, the purposes of claim 11 would not have provided motivation or occasion for the Applicant to consider either the *Schmier* or *Fruchey* references as analogous art because of their apparently divergent purposes.

The Action inappropriately argues that *Schmier* is analogous art, stating, “[s]ince package delivery and passenger delivery are similar in intent and purpose, applying the techniques and procedures to each are intuitive as well as cross-functional.” Action, p. 3. Moreover, the Action does not even argue that *Fruchey* is analogous art. Regardless, merely stating that *Schmier* and the invention of claim 11 are similar in purpose is not sufficient explanation and, frankly, is incorrect. As shown above, the intended purposes of both systems are divergent and would not have led an inventor of claim 11 to consider the others. Hence, the rejection of claim 11 is inappropriate for the additional reason that the combination of references proposed by the Action includes references (i.e., *Schmier* and *Fruchey*) that are not available as prior art under 35 U.S.C. § 103. Applicant asserts that the rejection of claim 11 should therefore be overturned.

c. No suggestion or motivation to combine *Schmier*, *Dlugos*, Applicant's disclosure, Hitchcock and Fruchey

Even if *Schmier* and *Fruchey* were deemed analogous art for the sake of argument, the Action fails to make a *prima facie* case of obviousness because the Action fails to establish the suggestion or motivation to combine the references in the manner suggested. Regardless of whether all claim elements are present in the prior art, the Patent Office has the burden of establishing that there was some motivation to combine or modify the teachings of the prior art to meet the claim limitations. See *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984). Moreover, the Patent Office must not use conclusory statements in making its *prima facie* case. *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002). “Reasoned findings are critical to the performance of agency functions.” *Id.* The Action attempts to provide several overly broad “motivations” for why it would be obvious to combine *Schmier* with *Dlugos* and Applicant’s disclosure: “providing a more efficient delivery to the customer,” “the value to the customer is increased,” and, quoting *Dlugos*, “‘provides a more convenient and efficient form in which to transport information related to and accompanying parcels’ and ‘a more convenient form in which to store information relating to the contents of a storage location for goods.’ ” Action, pp. 4-6. These “motivations” amount to no more than “conclusory statements” and improper hindsight *post facto* rationalizations on the part of the Action. Ultimately, it is the prior art itself, and not the hindsight use of Applicant’s achievement, that must establish the obviousness of the combination. *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998).

There is no motivation or suggestion within the text of *Schmier* to add the parcel information system disclosed in *Dlugos*. Nor does *Schmier* even suggest a need for *Dlugos*’ system for transporting accompanying information with a parcel. This is reinforced by the fact that both

references serve completely divergent purposes. *See supra* Part D.1.b. The Federal Circuit has recently found that the motivation or suggestion to combine is strongest when it comes from the text of the prior art itself. *See In re Thrift*, 298 F.3d 1357, 1364 (Fed. Cir. 2002) (finding motivation in prior art language suggesting use of speech recognition in computer interface). Here, the Action's conclusory statements of efficiency, convenience, and customer value do not cure the lack of a suggestion or motivation to combine in either *Schmier* or *Dlugos*.

Moreover, even if there were a suggestion to combine *Schmier* with *Dlugos* and Applicant's disclosure in the manner suggested by the Action, the resulting combination would certainly frustrate the purposes of the references. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *Gordon*, 733 F.2d at 902. Ignoring the fact that not every element of claim 1 is found in the references, (*See infra* Part D.1.a.) if *Schmier* were modified by combining it with the other references cited, *Schmier*'s intended purpose would be frustrated. Specifically, "notifying a passenger waiting for a public transit vehicle of the arrival time of the vehicle at a public stop" where the "[v]ehicle 12 is scheduled to stop at one or more public transit stops 20 located on its route," would be inoperable in the new combination because the parcel information system of *Dlugos* and the package delivery system of Applicant's "Related Art" do not make public transit stops. *See Schmier*, col. 3, lines 13-15; col. 9, lines 23-25. Assuming *arguendo* that the alleged motivation to combine the references was proper, the proposed combination of *Schmier*, *Dlugos* and Applicant's disclosure still would not result in the invention of claim 1. Hence, for at least the above independent reasons, the rejection of exemplary claim 1 should be overturned.

E. Issue Five

1. Discussion of Group I: Claims 22, 23, 34, and 35 are patentable over *Schmier*, *Dlugos*, Applicant's disclosure, Hitchcock and Nathanson

The Office Action rejected claim 23 (the exemplary claim) under 35 U.S.C. § 103(a) as being unpatentable over *Schmier* in view of *Dlugos*, Applicant's disclosure, Hitchcock, and *Nathanson*. Applicant requests that the rejection of claim 23 be overturned and submits that the rejection was improper for at least the reasons that the combination of references fails to teach each and every element of claim 23, the *Schmier* reference is not analogous art for purposes of 35 U.S.C. § 103, and the references cited offer no suggestion or motivation for their combination. Each of these reasons are distinct and will serve as an independent basis for overturning the rejection of claim 23.

a. Combination of references fails to teach each step of claim 23

Independent claim 23, the exemplary claim of this claim group, recites:

23. The method of claim 16, further comprising the steps of:
maintaining a web page;
receiving contact information via said web page; and
utilizing said contact information to perform said transmitting step.

(*Emphasis added*). Applicant respectfully asserts that the rejection of claim 23 is improper because, even if the teachings of the references were properly combinable, such combination would not result in Applicant's claimed invention. For obviousness claim rejections under 35 U.S.C. § 103, the prior art when combined must teach or suggest all the limitations of the rejected claim. See *Pfaff v. Wells Elecs.*, 124 F.3d 1429, 1437 (Fed. Cir. 1997). As provided

above, Applicant's independent claim 23 provides a method including the steps of maintaining a web page and using it to receive contact information, contact information which is then used to transmit the notification message.

The proposed combination of *Schmier* in view of *Dlugos*, Applicant's disclosure, Hitchcock, and *Nathanson*, if proper, would not result in the claimed system for at least the reason that neither *Schmier*, *Dlugos*, Applicant's "Related Art," Hitchcock, nor *Nathanson* disclose, teach or suggest the features of (1) "receiving contact information via said web page," or (2) "using said contact information to perform said transmitting step," as recited in claim 23.

Schmier appears to disclose a system for notifying passengers in a transit system about the status of transit vehicles, vehicles which stop at predetermined transit stops regardless of the identity or quantity of the passengers on board. Abstract. Accordingly, *Schmier* suggests an approach for tracking the vehicle itself and not the individual passengers on board the vehicle. Although *Schmier* appears to disclose the use of personal computers in providing route information to customers, *Schmier* does not suggest using a web page to gather contact information for use in transmitting notification messages. Rather, the mass transit system of *Schmier* appears to provide access to updated vehicle schedules via computer, and not for collecting information on individual passengers within the transit system.

Similarly, the limitations of claim 23 that are not found in *Schmier* are also not found within *Dlugos*, Applicant's disclosure, Hitchcock or *Nathanson*. *Dlugos* appears to disclose a method of transporting a parcel together with parcel information using an attached integrated circuit card. Col. 16, lines 22-25. *Dlugos* makes no reference to collecting contact information about parcel recipients via a web page in order to transmit notification messages. Additionally, Applicant's "Related Art" disclosure does not teach or suggest the steps of maintaining a web

page for the purpose of collecting contact information about individual package recipients. Neither does Hitchcock's bar-code-based warehouse management system even suggest the use of web pages to gather contact information about order recipients. Finally, the vehicle delivery routing and management system of *Nathanson* does not address the use of a web page to gather information about package recipients. Rather, *Nathanson* relates to the routing and tracking of emergency and non-emergency vehicles in vehicle delivery environments. Contact information is not gathered via a web page in *Nathanson*.

Ultimately, the unlikely combination of *Schmier*, *Dlugos*, Applicant's "Related Art," Hitchcock, and *Nathanson* does not disclose, teach or suggest many of the features of claim 23. The missing features comprise at least "receiving contact information via said web page," and "using said contact information to perform said transmitting step." Applicant asserts that, due to the absent elements, the combination of the proposed references would not result in the invention of claim 23, and that its rejection was therefore improper and should be overturned.

b. *Schmier* is not analogous prior art

Applicant respectfully reasserts the arguments of Part A.1.b., alleging that it is improper to use *Schmier* as prior art against the invention because the reference is not analogous prior art, and therefore its use in the rejection of claim 23 under 35 U.S.C. § 103 is inappropriate and should be overturned.

c. No suggestion or motivation to combine *Schmier*, *Dlugos*, Applicant's disclosure, Hitchcock, and Nathanson

Even if *Schmier* were deemed analogous art for the sake of argument, the Action fails to make a *prima facie* case of obviousness because the Action fails to establish the suggestion or motivation to combine the references in the manner suggested. Regardless of whether all claim elements are present in the prior art, the Patent Office has the burden of establishing that there was some motivation to combine or modify the teachings of the prior art to meet the claim limitations. *See In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984). Moreover, the Patent Office must not use conclusory statements in making its *prima facie* case. *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002). "Reasoned findings are critical to the performance of agency functions." *Id.* The Action attempts to provide several overly broad "motivations" for why it would be obvious to combine *Schmier* with *Dlugos*, Applicant's disclosure, Hitchcock, and *Nathanson*: "efficient and uncomplicated," "improving customer satisfaction and overall efficiency," "accuracy in delivery is increased which improves customer satisfaction," "provides good customer service by saving the recipient time," and, quoting *Dlugos*, " 'provides a more convenient and efficient form in which to transport information related to and accompanying parcels' and 'a more convenient form in which to store information relating to the contents of a storage location for goods.' " Action, pp. 29, 20-23. These "motivations" amount to no more than "conclusory statements" and improper hindsight *post facto* rationalizations on the part of the Action. Ultimately, it is the prior art itself, and not the hindsight use of Applicant's achievement, that must establish the obviousness of the combination. *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998).

There is no motivation or suggestion within the text of *Schmier* to add the parcel information system disclosed in *Dlugos*. Nor does *Schmier* even suggest a need for *Dlugos*' system for transporting accompanying information with a parcel. This is reinforced by the fact that both references serve completely divergent purposes. *See supra* Part E.1.b. The Federal Circuit has recently found that the motivation or suggestion to combine is strongest when it comes from the text of the prior art itself. *See In re Thrift*, 298 F.3d 1357, 1364 (Fed. Cir. 2002) (finding motivation in prior art language suggesting use of speech recognition in computer interface). Here, the Action's conclusory statements of efficiency, convenience, and customer value do not cure the lack of a suggestion or motivation to combine in either *Schmier* or *Dlugos*.

Moreover, even if there were a suggestion to combine *Schmier* with *Dlugos*, Applicant's disclosure, Hitchcock, and *Nathanson* in the manner suggested by the Action, the resulting combination would certainly frustrate the purposes of the references. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *Gordon*, 733 F.2d at 902. Ignoring the fact that not every element of claim 23 is found in the references, (*See infra* Part E.1.a.) if *Schmier* were modified by combining it with the other references cited, *Schmier*'s intended purpose would be frustrated. Specifically, "notifying a passenger waiting for a public transit vehicle of the arrival time of the vehicle at a public stop" where the "[v]ehicle 12 is scheduled to stop at one or more public transit stops 20 located on its route," would be inoperable in the new combination because the parcel information system of *Dlugos*, the package delivery system of Applicant's "Related Art," the warehouse management system of Hitchcock, and the vehicle delivery management system of *Nathanson* do not make public transit stops and rather deal with individual customers and/or recipients. *See Schmier*, col. 3, lines 13-15; col. 9, lines 23-25.

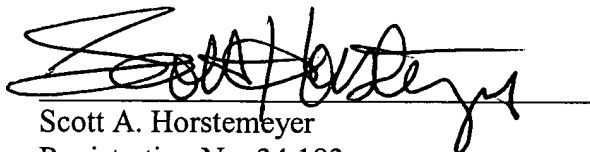
Assuming *arguendo* that the alleged motivation to combine the references was proper, the proposed combination of *Schmier*, *Dlugos*, Applicant's disclosure, *Hitchcock*, and *Nathanson* still would not result in the invention of claim 23. Hence, for at least the above independent reasons, the rejection of exemplary claim 23 should be overturned.

IX. CONCLUSION

Based upon the foregoing discussion, Applicant respectfully requests that the Examiner's final rejection of claims 1-37 be overruled and overturned by the Board, and that the application be allowed to issue as a patent with all pending claims 1-37.

A check in the amount of \$160.00 is enclosed herewith to cover the fee for this Appeal Brief. No additional fees are believed to be due in connection with this Appeal Brief. If, however, any additional fees are deemed to be payable, you are hereby authorized to charge any such fees to deposit account No. 20-0778.

Respectfully submitted,


Scott A. Horstemeyer
Registration No. 34,183

THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.
100 Galleria Parkway, Suite 1750
Atlanta, Georgia 30339
(770) 933-9500

X. APPENDIX

Claims

1. A system for reporting impending vehicle deliveries, comprising:

memory storing a vehicle schedule, said vehicle schedule identifying packages that are to be respectively delivered to a plurality of recipients by a vehicle during a first time period and indicating an order that said vehicle is expected to deliver said packages;

a first communications device configured to establish communication with remote communications devices; and

a system manager configured to analyze said vehicle schedule and to determine, based on said order, a second time period that said vehicle is expected to deliver one of said packages, said system manager further configured to transmit a notification message for a respective one of said recipients of said one of said packages via said first communications device, said notification message identifying said second time period,

wherein said second time period is within said first time period.

2. The system of claim 1, wherein said notification message is an e-mail message.

3. The system of claim 1, wherein said first time period is a day.

4. The system of claim 1, wherein said vehicle schedule identifies each recipient that is to receive at least one of said packages, said notification message identifying each of said packages to be received by one of said recipients during said first time period.

5. A system for reporting impending vehicle deliveries, comprising:

memory storing package data identifying a plurality of packages that are to be respectively delivered to a plurality of recipients;

a first communications device configured to establish communication with remote communications devices; and

a system manager configured to detect when one of said packages has been assigned to a vehicle for delivery to one of said recipients, said system manager further configured to transmit a notification message for a respective one of said recipients via said first communications device at a time after a detection that said one of said packages for said one of said recipients has been assigned to said vehicle is determined.

6. The system of claim 5, further comprising:

a scanner configured to scan a label of said package and to identify said one package based on said label, wherein said system manager detects that said package has been assigned to said vehicle based on whether said scanner has identified said one package.

7. The system of claim 5, wherein said notification message is an e-mail message.

8. The system of claim 5, wherein said package data indicates whether said one package has been assigned to said vehicle and said system detects when said one package has been assigned to said vehicle by analyzing said package data.

9. The system of claim 5, wherein said notification message identifies a sender of said one package.

10. The system of claim 5, wherein said package data indicates that said packages are to be delivered by said vehicle and indicates an order that said vehicle is expected to deliver said packages, and wherein said system manager is further configured to determine, based on said order, that said one package is expected to be delivered during a particular time period, said notification message indicating that said one package is expected to be delivered during said particular time period.

11. The system of claim 5, wherein said system manager is further configured to determine when said vehicle is within a predefined proximity of a premises of said one recipient based on signals transmitted from said vehicle, said system manager further configured to transmit a second notification message when said vehicle is within said predefined proximity.

12. A method for reporting impending vehicle deliveries, comprising the steps of:
receiving a plurality of packages;
assigning each of said packages to a vehicle;
determining an order that said vehicle is to deliver said packages;
determining, based on said order, a first time period that said vehicle is expected to deliver one of said packages to a recipient;
causing a notification message to be transmitted to said recipient based on said determining a first time period step;
indicating said first time period via said notification message;
simultaneously transporting each of said packages via said vehicle; and
transporting said one package to a premises of said recipient via said vehicle.

13. The method of claim 12, further comprising the step of transmitting said notification message via an e-mail message.

14. The method of claim 12, further comprising the steps of:
determining whether each of said packages is expected to be delivered during a second time period; and
performing said assigning step based on said determining whether step, wherein said first time period is within said second time period.
15. The method of claim 14, wherein said second time period is a day.
16. A method for reporting impending vehicle deliveries, comprising the steps of:
receiving a package for delivery to a premises of a recipient;
assigning said package to a vehicle;
detecting when said package is assigned to said vehicle;
producing a notification message based upon said detecting step; said notification message indicating a time period in which said package is expected to be delivered at said premises;
transmitting said notification message to a recipient communication device; and
transporting said package to said premises via said vehicle.
17. The method of claim 16, further comprising the step of scanning a label of said package, wherein said detecting step further includes the step of detecting said scanning step.
18. The method of claim 16, further comprising the steps of:
storing data indicating whether said package is assigned to a vehicle;
analyzing said data; and
performing said detecting step based on said analyzing step.
19. The method of claim 16, wherein said notification message is an e-mail message.

20. The method of claim 16, further comprising the steps of:
determining when said vehicle is within a predetermined proximity of said premises;
and
transmitting a second notification message in response to said determining step.

21. The method of claim 16, further comprising the step of indicating, via said notification message, a sender of said package.

22. The method of claim 16, further comprising the step of indicating, via said notification message, a weight of said package.

23. The method of claim 16, further comprising the steps of:
maintaining a web page;
receiving contact information via said web page; and
utilizing said contact information to perform said transmitting step.

24. A system for reporting impending vehicle deliveries,
comprising:
means for receiving a plurality of packages;
means for assigning each of said packages to a vehicle;
means for determining an order that said vehicle is to deliver said packages;
means for determining, based on said order, a first time period that said vehicle is
expected to deliver one of said packages to a recipient;
means for causing a notification message to be transmitted to said recipient, said
notification message indicating said first time period;
means for simultaneously transporting each of said packages via said vehicle; and
means for transporting said one package to a premises of said recipient via said vehicle.

25. The system of claim 24, wherein said notification message is transmitted via an e-mail message.

26. The system of claim 24, further comprising:
means for determining whether each of said packages is expected to be delivered during a second time period; wherein:

said packages are assigned to said vehicle based on an expectation of delivery during said second time period; and

said first time period is within said second time period.

27. The system of claim 24, wherein said second time period is a day.

28. A system for reporting impending vehicle deliveries, comprising:
means for receiving a package for delivery to a premises of a recipient;
means for assigning said package to a vehicle;
means for detecting when said package is assigned to said vehicle;
means for producing a notification message at a time after said package is detected, said notification message indicating a time period in which said package is expected to be delivered at said premises;
means for transmitting said notification message to a recipient communications device;
and
means for transporting said package to said premises via said vehicle.

29. The system of claim 28, further comprising:
means for scanning a label of said package and identifying said package based on said label, wherein said means for detecting detects that said package has been assigned to said vehicle based on whether said means for scanning has identified said package.

30. The system of claim 28, further comprising:
means for storing data indicating whether said package is assigned to a vehicle; and
means for analyzing said data, wherein a detection of said package being assigned to said vehicle is based on an analysis of said data.

31. The system of claim 28, wherein said notification message is an e-mail message.

32. The system of claim 28, further comprising:
means for determining when said vehicle is within a predetermined proximity of said premises; and
means for transmitting a second notification message at a time after said vehicle is determined to be within said predefined proximity.

33. The system of claim 28, further comprising:
means for indicating, via said notification message, a sender of said package.

34. The system of claim 28, further comprising:
means for indicating, via said notification message, a weight of said package.

35. The system of claim 28, further comprising:
means for maintaining a web page;
means for receiving contact information via said web page; and
means for utilizing said contact information to perform said transmitting step.

36. The system of claim 4, wherein said notification message is transmitted to a recipient remote communications device of said one of said recipients.

37. The system of claim 11, wherein said first and second notification messages are transmitted to a recipient remote communications device of said one recipient.